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In re Application of	:	
CARBONE, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/582,297	:	
PCT No.: PCT/US98/27268	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 22 December 1998	:	
Priority Date: 24 December 1997	:	
Attorney Docket No.: 06975-029006	:	
For: ASYNCHRONOUS DATA PROTOCOL	:	

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(a)" filed 10 October 2000.

### **BACKGROUND**

On 22 December 1998, applicant filed international application PCT/US98/27268, which claimed priority of an earlier application filed 24 December 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 02 September 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 July 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 June 2000.

On 23 June 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1). An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 10 July 2000, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was also notified of the need to pay the \$130.00 surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 10 October 2000, applicant responded with the present petition accompanied by

payment of the \$130.00 surcharge, payment of the \$130.00 petition fee for a petition under 37 CFR 1.47(a), a petition for a two-month extension of time, payment of the two-month extension of time fee and a combined declaration and power of attorney executed by inventors: Kenneth Carbone, Marc A. Katchay, Harry G. Morgan and Scott A. Quillen.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1) and (3), applicants have enclosed a check for the required petition fee of \$130.00 and the petition states the last known address of the non-signing inventor, Mr. Robert D. Greenlee.

Regarding Item (4), accompanying the petition is a declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor. Accordingly, Items (1), (3) and (4) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." In the present petition the only evidence of such an attempt is the statement of counsel that the appropriate papers, "were mailed on two separate occasions to Mr. Greenlee at his home address by a representative of America Online, Inc., the employer of all the applicants at the time of the invention." This is insufficient. In order to satisfy Item (2) applicant must provide a declaration from the individual with firsthand knowledge of what materials were sent to Mr. Greenlee, how they were sent and the nature of his refusal to accept and/or execute the declaration. In addition, it is necessary to provide copies of the receipts of mailing be it certified mail receipts or Express Mail receipts which show Mr. Greenlee's address and dates of attempted delivery.

In light of the above, applicant's petition cannot be granted.

### CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice.**

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all

inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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